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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,645	12/20/2000	Masahiro Komura	1341.1076 (JDH)	4243

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/739,645	Applicant(s) KOMURA ET AL.	
	Examiner Carl Colin	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20061121</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal brief filed on September 15, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Nasser G. Moazzami.



Response to Arguments

2. In response to communications filed in the appeal brief on 9/15/2006, the following claims 1-17 are presented for examination.

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2.1 Applicant's arguments, pages 16-17, filed in the appeal brief on 9/15/2006, with respect to the rejection of claims 16-17 have been fully considered, but they are not persuasive.

Regarding claims 16-17, Applicant argues that in Torii the vendor does not receive information about "design error or bug in a computer product" as recited in claim 16 or about "a security flaw in a product" as recited in claim 17. Examiner respectfully disagrees. Torii discloses,

"The refund processing unit 51 refers the installation history received from the user terminal only when the refund requesting user is a genuine user who actually bought the software. The refund processing unit 51 then determines whether the start code alone is recorded in the installation history or both the start and termination codes are recorded therein. If only the start code is recorded in the installation history, the refund processing unit 51 determines that the installation is terminated abnormally and carries out operation to refund the money for the software. The refund processing unit 51 notifies the user of the processing result." (column 9, line 60 - column 10, line 3).

Therefore, Torii discloses unit 51 receiving information about anomaly in a computer program. As disclosed above, the installation history contains information about the start code and termination codes about a program that shows whether the program has a defect (terminates abnormally), which meets the recitation of *design error or bug in a program* as claimed in claims 16-17.

Applicant adds "therefore Torii does not teach determining that information received from a verified user regarding a security flaw in a product is valuable". Examiner respectfully disagrees. As shown above, there is determination by unit 51 as to whether the installation history contains valuable information that proves that the software does terminate abnormally. Torii also discloses an example of determining information regarding a defect (*security flaw*) that is not valuable as follow:

"On the contrary, if both the start and termination codes are recorded in the installation file, the refund processing unit 51 determines that the requesting user is a dishonest one who requests to refund the money in spite

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that the installation is terminated normally. The refund processing unit 51 registers the access number of the requesting user in the fraud user file 46c." (column 10, lines 4-10).

Therefore, as disclosed in col 9, line 60 through col 10, line 10, Torrii discloses "determining that information received from a verified user regarding a security flaw in a product is valuable".

Applicant further alleges "consequently Torii does not teach either rewarding the user for submitting the information." Examiner respectfully disagrees. Torrii discloses a refund to the user in the form of money or payment that meets the recitation of *reward*:

"An object of the present invention is thus to provide a system for refunding payment for software that is capable of determining a fraud of a user to refund the payment only to those having a proper right of receiving the money in the software distribution system that stores a large number of software of which functions are limited on CD-ROMs for distribution at a relatively low price and the end users pay for their desired software to obtain a code for eliminating the functional limitations." (column 1, lines 51-60).

In response to Applicant that "reward" as claimed is patentably distinct from "refund of money or payment" of Torii, as defined in the American Heritage College Dictionary, **a reward is something given or received in recompense for worthy behavior.** To reward is also defined as **1. To give a reward to or for 2. To satisfy or gratify** Torii discloses a user has to be entitled to receive a refund, the user has to provide proof that the software has a problem or does not work. If user is a dishonest user submitting a fraud request as cited above, the user is not compensated meaning no reward is received.

As mentioned previously in the previous Office action, regarding claim 17, in response to Applicant's request to the Examiner to explain where and how Torii discloses a "security flaw", Examiner would like to clarify that the term "security flaw" added in claim 17 in the response filed on 6/30/2005 by applicant was interpreted by Examiner in light of the specification as discussed above as "security information regarding information regarding design error or bug"

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rather than a failure by applicant to comply with the written description requirement because the term “security flaw” is not disclosed in the original specification. In fact, Applicant’s brief page 8 in the summary of claimed subject matter describes claims 16 and 17 as disclosing the same i.e. “design error or bug”. Therefore claims 16 and 17 are objected to as set forth below.

Applicant has not overcome the rejection of claims 16 and 17 in view of Torii, and a new ground of rejection is set forth below.

Claim Objections

3. Claim 17 is objected to as being a substantial duplicate of claim 16. Applicant is advised that should claim 16 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application and must produce a useful, concrete, and tangible result. Claims 16 and 17 reciting

“*determining whether that information received is valuable*” do not produce a concrete result because the mere fact of “determining whether something is valuable” is subjective and would not produce a result that can be substantially repeatable. See MPEP § 2106, IV, C.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,761,308 to **Torii et al.**

As per claim 16, Torii et al substantially teaches a method of collecting information over a network comprising: *determining that information* (installation history) *received from a verified user* (column 9, lines 60-62) (regarding an anomaly or defect of a software is valuable) that meets the recitation of *regarding a design error or bug in a computer program is valuable* (column 9, line 63 through column 10, line 10); (refunding the user money or payment for

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submitting the information) that meets the recitation of *rewarding the user for submitting the information* (see column 10, lines 1-3 and column 1, lines 51-60). Torii et al discloses, a center comprises a refund processing unit 51 which determines whether the installation history from the user really contains proof of abnormal termination of the software, the information in the installation history is valuable to the center because the user deserves a refund if it determines to be true information. As shown herein the only difference between the claimed invention and the reference is the use of the term refund in the reference. As defined in the American Heritage College Dictionary, **a reward is something given or received in recompense for worthy behavior.** To reward is also defined as **1. To give a reward to or for 2. To satisfy or gratify**, which meets the claimed limitation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the term refund of money for reward in order to provide to the user a form of compensation that would satisfy the user after the user realizes that he/she spends money for a software that does not work normally and sends proof of it, as the difference in the terms do not make the invention patentably distinct.

As per claim 17, Torii et al substantially teaches a method of collecting information over a network comprising: *determining that information* (installation history) *received from a verified user* (column 9, lines 60-62) (regarding an anomaly or defect of a software is valuable) that meets the recitation of *regarding a security flaw in a product is valuable* (column 9, line 63 through column 10, line 10); (refunding the user money or payment for submitting the information) that meets the recitation of *rewarding the user for submitting the information* (see column 10, lines 1-3 and column 1, lines 51-60). Torii et al discloses, a center comprises a

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refund processing unit 51 which determines whether the installation history from the user really contains proof of abnormal termination of the software, the information in the installation history is valuable to the center because the user deserves a refund if it determines to be true information. As shown herein the only difference between the claimed invention and the reference is the use of the term refund in the reference. As defined in the American Heritage College Dictionary, **a reward is something given or received in recompense for worthy behavior.** To reward is also defined as **1. To give a reward to or for 2. To satisfy or gratify,** which meets the claimed limitation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the term refund of money for reward in order to provide to the user a form of compensation that would satisfy the user after the user realizes that he/she spends money for a software that does not work normally and sends proof of it, as the difference in the terms do not make the invention patentably distinct.

Allowable Subject Matter

6. Claims 1-15 are allowed. The following is an examiner's statement of reasons for allowance: Applicant's arguments regarding the rejection of claim 1-15 are persuasive. The prior art of record US Patent 5,761,308 to Torii et al teaches a system and method wherein a user stores an installation history file (security information) comprising information about an anomaly in a software and sends the installation history file to a center; the center comprising a registering unit (46), which registers the security information in a database and other units (50) and (51) judge the usefulness of the security information and when it finds that the security information has usefulness, payment information is transferred to the first terminal user. Torii does not teach

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a three-party for handling the security information as claimed in claims 1, 8, and 15. US Patent 6,327,578 to Linehan teaches a four-party credit/debit payment in electronic commerce that includes a consumer, a merchant and third parties such as a gateway issuer and a bank. The gateway issuer issues an authorization token either to the consumer or the merchant to validate that a payment is authorized and once the merchant has received the authorization token from the issuer gateway the merchant completes the transaction with the consumer and gets paid. Linehan does not teach a security information regarding a design error or bug and does not teach the steps of registering, receiving, and transferring as claimed in claims 1, 8, and 15. The prior arts of record, fail to teach singly or in combination: a first transferring unit which receives a security information regarding a design error or bug registered at the first registering in a first database and transfers the security information registered at the first registering to a second terminal at an information recipient for judging usefulness of the security information and a second transfer unit which receives at least the reply information registered in a second database from a second registering unit and transfers the payment information with the reply information to the first terminal as claimed in claim 1. Claims 8 and 15 recite respectively a method and computer readable medium and contain similar limitations. Consequently claims 1, 8, and 15 are allowable over the prior art of record. Claims 2-7 and 9-14 are directly or indirectly dependent upon claims 1 and 8, and therefore are also allowable over the prior art of record.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Non-Patent Literature:

- a) Forrest J. Cavalier, "Some Implications of Bazaar Size", Third Draft Aug. 11, 1998 III
Mib Software; Pages 14.

"<http://web.archive.org/web/19991013203739/www.mibsoftware.com/bazdev/0012.htm>".

This art discloses the importance of encouraging user for reporting defects in a computer program (design error, bug, or security flaw) and the importance of rewarding users for reporting software defects (design error, bug, or security flaw).

- b) Randall Hyde, 1997; Pages 1-3; "<http://www.cs.ucr.edu/~rhyde/cs140/cs140S97.htm>"

This document also discloses rewarding users for finding and reporting defects in a computer program.

7.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


cc

Carl Colin

Patent Examiner

November 22, 2006

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100


11, 24, 06